

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JEREMY BURR

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Appeal 2007-2920  
Application 09/930,779  
Technology Center 2600

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Decided: January 9, 2008

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Before KENNETH W. HAIRSTON, JOHN A. JEFFERY, and MARC S. HOFF,  
*Administrative Patent Judges.*

HAIRSTON, *Administrative Patent Judge.*

DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-30. We have jurisdiction under 35 U.S.C. § 6(b).

## SUMMARY OF DECISION

We REVERSE and enter a new ground for rejection against claims 1-30 under 37 C.F.R. § 41.50 (b).

## INVENTION

Appellant's claimed invention is to a mobile ad hoc network (MANET) established between a plurality of mobile devices (Spec. 3:18-20) by exchanging contact lists and establishing communication lists from a first station with other stations that may or may not be in-range, but are determined to have common contacts in their contact lists (Spec. 5:10-21).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method comprising:

obtaining, on a first wireless device, a contact list of second wireless devices with which the first wireless device has communicated in the past, including a first contact in-range from the first wireless device and a second contact being out-of-range from the first wireless device;

automatically establishing a communication route between the first wireless device and the first contact; and

automatically establishing a communication route from the first wireless device to a second contact through the first contact.

### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Haartsen	US 6,590,928 B1	Jul. 08, 2003
		(filed Sep. 17, 1997)

The following rejection is before us for review.

Claims 1-30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Haartsen.

### ANTICIPATION UNDER § 102(e)

Independent claims 1, 11 and 21 and their respective dependent claims 2-10, 12-20, and 22-30 were argued as a group with claim 1 as representative (Br. 7 and Br. 10-11).

The issue before us is whether the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102(e) as anticipated by Haartsen. The issue turns on whether Haartsen expressly or inherently discloses “a contact list of second wireless devices with which the first wireless device has communicated in the past, including . . . a second contact being out-of-range from the first wireless device.”

### FINDINGS OF FACT

The relevant facts include the following:

1. Haartsen in Figures 6a and 6b teaches automatically establishing a communication route between a first wireless device/unit A and a first contact/unit C and automatically establishing a communication route from the first wireless device/unit A to a second contact/unit B through the first

contact/unit C, wherein the first contact/unit C is in-range from the first wireless device/unit A and the second contact/unit B is out-of-range from the first wireless device/unit A (col. 8, ll. 1-12 and col. 14, ll. 17-36).

2. Haartsen discloses that through an extensive inquiry process each wireless device/unit learns the addresses of not only those units that are within range but also the addresses of those out-of-range units that are within range of accessible wireless devices/units serving as bridge/master units or intermediate units which serve to set up connections (col. 14, ll. 37-65).
3. Haartsen teaches creating a contact list of in-range second wireless devices/units with which the first wireless device/inquiring unit has communicated in the past (col. 13, l. 66-col. 14, l. 5).
4. It is undisputed that Haartsen does not teach creating a contact list of out-of-range second wireless devices/units with which the first wireless device/inquiring unit has communicated in the past (Ans. 5-6). Instead, Haartsen teaches that a contact list of the out-of-range second wireless device/destination unit is derived via the bridge/master units or intermediate units (col. 15, ll. 18-20).
5. Haartsen discloses that an inquired unit not only provides its own address list, but also the address lists it received from other units, which they obtained during their own inquiry sessions (col. 15, ll. 20-24).
6. The Specification states: "Each device includes a contact list. A contact list may be a list of individuals with whom the device has communicated in the past" (Spec. 4:8-11).

7. The claimed limitation of “a contact list of second wireless devices with which the first wireless device has communicated in the past” was introduced in independent claims 1 and 11 and the equivalent claimed limitation “that the system has communicated with before” was introduced in independent claim 21 in the amendment filed May 12, 2005. There is no support for this limitation in the Application as originally filled.
8. Figure 1 of the current disclosure shows sharing common contacts within the in-range wireless devices; however, there is no disclosure that the out-of-range wireless device A has communicated with the first wireless device X in the past (Spec. 4:17-5:5).
9. The Specification discloses that communication links may be established between the in-range and out-of-range wireless devices through in-range common contacts (Spec. 5:10-21), but nothing requires past communication of the first wireless device X with the out-of-range wireless devices.

#### PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. Inc., v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Under the written description portion of the first paragraph of 35 U.S.C. § 112, the Applicants must convey with reasonable clarity to those skilled in the art that they had possession of the invention as of the filing date sought. *Vas-Cath*,

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*Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991); *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983).

## ANALYSIS

### **Did the Examiner err in construing the claimed phrase “second wireless devices” as meaning only in-range wireless devices?**

Appellant argues that the claim requires that a contact list includes in-range and out-of-range devices with which the first wireless device has communicated with in the past (Br. 10). The Appellant asserts that in *Haartsen* the out-of-range wireless devices are not devices with which the first wireless device has communicated with in the past (Br. 10). Appellant further argues that the Examiner’s interpretation of “contact list” to include devices with which the first wireless device has not communicated in the past is inconsistent with the claimed “contact list” qualification “of second wireless devices with which the first wireless device has communicated in the past” (Reply Br. 1).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. Inc., v. Union Oil Co. of California*, 814 F.2d at 631.

The disputed claim limitation states: “obtaining, on a first wireless device, a contact list of second wireless devices with which the first wireless device has communicated in the past, including a first contact in-range from the first wireless device and a second contact being out-of-range from the first wireless device.” Thus, the claim requires a contact list obtained via the first contact in-range

wireless device and the second contact out-of-range wireless device. Most importantly, both of these constitute “second wireless devices” with which the first wireless device has communicated with in the past.

Haartsen discloses automatically establishing a communication route between a first wireless device and the first contact and automatically establishing a communication route from the first wireless device to a second contact through the first contact (Findings of Fact 1 and 2). Haartsen discloses in-range and out-of-range devices as part of the contact list (Findings of Fact 2 and 5). Haartsen also discloses obtaining a contact list of a second wireless in-range device with which the first wireless device has communicated with in the past (Finding of Fact 3). It is undisputed that Haartsen does not disclose a second out-of-range wireless device with which the first wireless device has communicated with in the past (Findings of Fact 4 and 5).

Thus, claim 1 is not anticipated because Haartsen neither expressly nor inherently discloses past communication with the out-of-range secondary wireless device. The Examiner’s attempt to cure this deficiency by interpreting the “second wireless devices” to include only the in-range wireless device (Ans. 5-6) is in error, as the claim limitation qualifies the “second wireless devices” to include both in-range and out-of-range wireless devices.

We are thus persuaded by Appellant’s argument that claim 1 is not anticipated by Haartsen since the reference does not disclose past communication between a first wireless device and an out-of-range secondary wireless device. As indicated *supra*, the same or similar limitation is found in independent claims 11

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and 21 (Finding of Fact 7).

### CONCLUSIONS OF LAW

We conclude that the Appellant has shown that the Examiner erred in rejecting claims 1-30.

We use our authority under 37 C.F.R. § 41.50 (b) to enter a new ground of rejection of claims 1-30 as set forth below.

### NEW GROUNDS OF REJECTION UNDER 35 U.S.C. § 112

Claims 1-30 are rejected under the first paragraph of 35 U.S.C. § 112 for lack of written description.

Under the written description portion of the first paragraph of 35 U.S.C. § 112, the Applicants must convey with reasonable clarity to those skilled in the art that they had possession of the invention as of the filing date sought. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563-64; *In re Kaslow*, 707 F.2d at 1375.

The claimed language of “a contact list of second wireless devices with which the first wireless device has communicated in the past” was introduced in independent claims 1 and 11 and the equivalent claim language “that the system has communicated with before” was introduced in independent claim 21 in the amendment filed May 12, 2005. There is no support for this limitation in the Application as originally filed (Finding of Fact 7). The Specification only states: “Each device includes a contact list. A contact list may be a list of individuals with whom the device has communicated in the past” (Finding of Fact 6). The Specification does not state that the contact list “must” be



a list of individuals with whom the "first wireless device" has communicated with in the past. Also, the disclosure and the explanation of Figure 1 only provides support for sharing common contacts within the in-range wireless devices, however, there is no support, for example, that wireless device A has communicated with first wireless device X in the past (Finding of Fact 8). Furthermore, communication links may be established between the in-range and out-of-range wireless devices through in-range common contacts, but again nothing requires past communication of the first wireless device X with the out-of-range wireless devices (Finding of Fact 9). Thus, there is no supporting disclosure for the limitations added by amendment, and hence these limitations constitute new matter.

### DECISION

The decision of the Examiner to reject claims 1-30 is reversed.

We have entered a new ground of rejection against claims 1-30 under 37 C.F.R. § 41.50 (b).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

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37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED  
37 C.F.R. § 41.50(b)

Tdl/gw

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